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| 10/719,777      | 11/21/2003  | Tina L. Grubb        | 98-70E              | 2884             |

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| EXAMINER |
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FEELY, MICHAEL J

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| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/719,777

Applicant(s)

GRUBB ET AL.

TA

Examiner

Michael J. Feely

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16 and 58-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-16 and 58-62 is/are rejected.
- 7) ☒ Claim(s) 1-6, 8-16 and 58-62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1103.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Pending Claims*

Claims 1-6, 8-16, and 58-62 are pending.

### *Claim Objections*

1. Claims 1-6, 8-16, and 58-62 are objected to because of the following informalities: On line 10 of claim 1 and on line 12 of claim 8, "plus B)" should be deleted. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 6, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Correll et al. (US Pat. No. 5,686,185) in view of Durand (US Pat. No. 5,334,631).

Regarding claims 1, 2, and 58, Correll et al. disclose:

- (1) a chip resistant coating on high tensile steel (column 1, lines 10-30) produced from a coating powder composition (column 1, lines 10-30) comprising:

- 100 weight parts of a resin chosen from:
  - (1) a resin comprising A) and epoxy resin (column 7, line 22 through column 8, line 11; column 9, lines 16-40) plus B) a polyhydroxyl functional cross-linker having a hydroxy equivalent weight of from 200 to 500 (column 8, lines 30-40; column 9, lines 16-40); and

(2) a resin comprising an adduct of from 75 to 95 wt%, based on the total weight of A) plus B), of an epoxy resin A), and from 5 to 25 wt%, based on the total weight of A) plus B), of an elastomer compound B) having a glass transition temperature of  $-30^{\circ}\text{C}$  or below; and

- *fillers that enhance corrosion resistance* (column 10, lines 37-52);

(2) wherein said epoxy resin is a bisphenol A epoxy resin (column 7, lines 36-41); and  
(58) a method for coating a high-tensile steel surface to provide a chip resistant coating according to claim 1 comprising applying said coating composition to said surface, and heating said coating composition to form a coating (column 11, lines 23-40).

Correll et al. disclose that fillers, especially fillers that are used to enhance corrosion resistance, can be employed in an amount up to about 100 phr (column 10, lines 37-45); however, they do not disclose: (1) at least 75 weight parts of zinc powder.

Durand discloses a powder coating composition comprising an epoxy resin, a curing agent, lamellar zinc, and zinc dust (including zinc powder) (*see column 1, line 57 through column 2, lines 8*). The combination of materials combines good corrosion protective properties and good film properties (*see column 1, lines 30-34*) to substrates including steel (*see column 3, lines 27-31*). The teachings of Durand demonstrate that zinc powder is known in the art as a suitable filler for epoxy-based, corrosion-resistant, powder-coating compositions. In light of this, it has been found that the selection of a known material based on its suitability for its intended use supports a *prima facie* obviousness determination – *see MPEP 2144.07*.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use zinc powder, as taught by Durand, in the composition of Correll et al. because

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Durand establishes that zinc powder is known in the art as a suitable filler in epoxy-based powder-coating compositions, resulting in excellent film properties and corrosion resistance.

Regarding claims 3 and 6, these limitations are not required; hence, these limitations are satisfied.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 4, 5, 6, 58, and 60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, and 6 of U.S. Patent No. 6,677,032 (Grubb et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of Grubb et al. is fully encompassed by instant claims 1 & 6, wherein the core-shell resin of Grubb et al. falls within the broader "adduct" of instant claim 1.

- Claim 3 of Grubb et al. corresponds to the limitations of instant claims 4, and 5; and
- Claim 6 of Grubb et al. corresponds to the limitations of instant claims 58 and 60.

6. Claims 8, 10-16, 59, and 61-62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 9-14, and 16-20 of U.S.

Patent No. 6,677,032 (Grubb et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 7 & 18 of Grubb et al. are fully encompassed by instant claim 8.

- Claim 9 of Grubb et al. corresponds to the limitations of instant claim 13;
- Claim 9 of Grubb et al. corresponds to the limitations of instant claim 11;
- Claim 10 of Grubb et al. corresponds to the limitations of instant claim 12;
- Claim 11 of Grubb et al. corresponds to the limitations of instant claim 14;
- Claims 12 & 19 of Grubb et al. correspond to the limitations of instant claim 16;
- Claims 13, 14 & 18 Grubb et al. correspond the limitations of instant claim 15;
- Claim 16 of Grubb et al. correspond to the limitations of instant claim 10;
- Claims 17 & 20 of Grubb et al. correspond to the limitations of instant claims 59, 61 & 62.

7. Claims 58-62 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 9, 13, and 16 of U.S. Patent No. 6,346,292 (Grubb et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of Grubb et al. is fully encompassed by instant claims 58 and 60, wherein the core-shell resin of Grubb et al. falls within the broader “adduct” of instant claims 58 and 60.

Claims 6 and 13 of Grubb et al. are fully encompassed by instant claims 59 and 61, wherein the core-shell resin of Grubb et al. falls within the broader “adduct” of instant claims 59 and 61.

- Claims 9 and 16 of Grubb et al. correspond to the limitations of instant claim 62.

*Allowable Subject Matter*

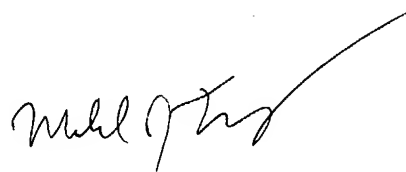
8. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Claims 4, 5, 8, 10-16, and 59-62 would be allowable if rewritten to overcome the ODP rejection(s) set forth in this Office action; or with a timely filed terminal disclaimer.
10. The following is a statement of reasons for the indication of allowable subject matter:  
*Regarding claims 4, 5, and 60*, the combined teachings of Correll et al. and Durand fail to teach zinc powder in amounts over 100 phr.  
*Regarding claims 8-16, 59, 61, and 62*, the combined teachings of Correll et al. and Durand fail to teach or suggest the dual coating set forth in claim 8, wherein the underlayer contains zinc powder and the top-layer is zinc free.

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely  
Patent Examiner  
Art Unit 1712

November 1, 2004